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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/143,967	08/31/1998	RANDAL LEE BERTMAN	RP9-95-017V	4218

7590 07/17/2003

Winstead, Sechrest & Minick P.C.  
5400 Renaissance Tower  
1201 Elm Street  
Dallas, TX 75270-2199

EXAMINER

HUYNH, BA

ART UNIT	PAPER NUMBER
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2173

23

DATE MAILED: 07/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/143,967

Applicant(s)

BERTMAN ET AL.

Examiner

Ba Huynh

Art Unit

2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 May 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 37-72 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 37-45, 47-57, 59-69, 71 and 72 is/are rejected.
- 7) ☒ Claim(s) 46, 58 and 70 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

BA HUYNH  
PRIMARY EXAMINER

Art Unit: 2173

### **DETAILED ACTION**

1. In view of the Board decision on 5/09/03, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the

Art Unit: 2173

reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 37, 49, 61 are rejected under 35 U.S.C. 102(e) as being anticipated by US patent #5,666,502 (Capps).

- As per claims 37, 49, 61: Capps teaches a handheld computer system comprising a housing, a processor mounted within the housing for processing digital data, a memory for storing digital data, a display, an input digitizer, a control program stored in the memory for processing of digital data (figures 1, 2; col. 4, line 39 – col. 5, line 52). The system displays a form defining data fields (figure 5a) and exercises a predictive widget (9:65 – 10:32; 11:32 – 12:24) to supply a data entry for a defined data field 184(figures 5b).

4. Claims 49-72 are rejected under 35 U.S.C. 102(e) as being anticipated by US patent #5,805,911 (Miller).

- As per claims 49, 61: Miller teaches a computer system comprising a housing, a processor mounted within the housing for processing digital data, a memory for storing digital data, a display, a control program stored in the memory for processing of digital data (figures 1-3). The system displays a form defining data fields 35 (figure 4) and exercises a predictive widget 43-47 (8:39-11:28) to supply a data entry for a defined data field 35(9:1-8) .

Art Unit: 2173

- As for claims 50, 62: The predicted entry is supplied to the data field by default (9:1-8)
- As for claims 51, 63: The system store a predictive list of entries (9:25-44) and selecting a default entry from the list based on a predetermined algorithm (9:1-8; 12:53-57).
- As for claims 52, 64: The predictive module provides a predicted list comprises a predictive fill entry for the defined data field 35 (9:1-8; 12:53-57).
- As for claims 53, 54, 65, 66: The system store a predictive list of entries (9:25-44) and selecting a default entry from the list based on a predetermined algorithm (9:1-8; 12:53-57).
- As for claims 55, 67: An entry can be selected based on the recency of use of listed data entries (10:20-39).
- As for claims 56, 68: An entry can be selected based on the frequency of use of listed data entries (9:45-49).
- As per claims 57, 69: An entry is selected based on weight determination of frequency and recency of use (8:56 – 9:8; 10:33-43; 11:1-7; 12:3-38).
- As per claims 59, 71: Data entries in the data field are captured and stored in the predictive list (10:20-25. See also the teachings of MRU and MFU).
- As per claims 60, 72: Miller teaches a computer system comprising a housing, a processor mounted within the housing for processing digital data, a memory for storing digital data, a display, a control program stored in the memory for processing of digital data (figures 1-3). The system displays a form defining data fields 35

Art Unit: 2173

(figure 4), captures data entries in the data field and stores the captured entries in the predictive list (10:20-25. See also the teachings of MRU and MFU), and exercises a predictive widget 43-47 (8:39-11:28) to supply a data entry for a defined data field 35(9:1-8).

*Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 37-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over US patent #5,805,911 (Miller).

- As for claims 37: Miller teaches a computer system comprising a housing, a processor mounted within the housing for processing digital data, a memory for storing digital data, a display, a control program stored in the memory for processing of digital data (figures 1-3). The system displays a form defining data fields 35 (figure 4), and exercises a predictive widget 43-47 (8:39-11:28) to supply a data entry for a defined data field 35(9:1-8). Miller fails to teach that the system is implemented in a mobile computer, however suggested that the system can be implemented in other general purpose computers. General purpose mobile computers such as Palmtop and Laptop computers are well known the field of data processing (See previously cited US patent #5,666,502 (Capps)). It would have been obvious to one

of ordinary skill in the art, at the time the invention was made, to implement Miller's teaching in a mobile computer. Motivation of the implementation is for the desirable advantage of the mobility of mobile computers.

- As for claim 38: The predicted entry is supplied to the data field by default (9:1-8)
- As for claim 39: The system store a predictive list of entries (9:25-44) and selecting a default entry from the list based on a predetermined algorithm (9:1-8; 12:53-57).
- As for claim 40: The predictive module provides a predicted list comprises a predictive fill entry for the defined data field 35 (9:1-8; 12:53-57).
- As for claims 41-42: The system store a predictive list of entries (9:25-44) and selecting a default entry from the list based on a predetermined algorithm (9:1-8; 12:53-57).
- As for claim 43: An entry can be selected based on the recency of use of listed data entries (10:20-39).
- As for claim 44: An entry can be selected based on the frequency of use of listed data entries (9:45-49).
- As per claim 45: An entry is selected based on weight determination of frequency and recency of use (8:56 – 9:8; 10:33-43; 11:1-7; 12:3-38).
- As per claim 47: Data entries in the data field are captured and stored in the predictive list (10:20-25. See also the teachings of MRU and MFU).
- As per claim 48: Miller teaches a computer system comprising a housing, a processor mounted within the housing for processing digital data, a memory for storing digital data, a display, a control program stored in the memory for processing of digital data

Art Unit: 2173

(figures 1-3). The system displays a form defining data fields 35 (figure 4), captures data entries in the data field and stores the captured entries in the predictive list (10:20-25. See also the teachings of MRU and MFU) and exercises a predictive widget 43-47 (8:39-11:28) to supply a data entry for a defined data field 35(9:1-8). Miller fails to teach that the system is implemented in a mobile computer, however suggested that the system can be implemented in other general purpose computers. General purpose mobile computers such as Palmtop and Laptop computers are well known the field of data processing (See previously cited US patent #5,666,502 (Capps)). It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to implement Miller's teaching in a mobile computer. Motivation of the implementation is for the desirable advantage of the mobility of mobile computers.

***Allowable Subject Matter***

7. Claims 46, 58 and 70 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ba Huynh whose telephone number is (703) 305-9794. The examiner can normally be reached on Mon - Fri.



Art Unit: 2173

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cabeca John can be reached on (703) 308-3116. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7238 for regular communications and (703) 746-7239 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800.

Ba Huynh  
Primary Examiner  
Art Unit 2173  
July 11, 2003

BA HUYNH  
PRIMARY EXAMINER